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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/757,321	01/14/2004	Yasuyuki Miyazawa	1576.89CIP	3511

24040 7590 08/18/2005  
DENNIS G. LAPOINTE  
LAPOINTE LAW GROUP, PL  
PO BOX 1294  
TARPON SPRINGS, FL 34688-1294

EXAMINER

NWAONICHA, CHUKWUMA O

ART UNIT PAPER NUMBER

1621

DATE MAILED: 08/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/757,321

Applicant(s)

MIYAZAWA ET AL.

Examiner

Chukwuma O. Nwaonicha

Art Unit

1621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-46 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-46 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. ____   |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date ____  | 6) <input type="checkbox"/> Other: ____                                     |

### DETAILED ACTION

Claims 1-46 are pending in the application.

#### ***Election/Restrictions***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

**Group 1.** Claims 1-4, 6, 12 and 41-46, drawn to an alcohol of the general formula II, the process for making the same, classified in class 544, subclass 298+.

**Group 2.** Claims 1-4, 6, 12 and 41-46, drawn to an aldehyde of the general formula II, process for making the same, classified in class 544, subclass 239+.

**Group 2.** Claim 5, drawn to a method for compound of general formula I classified in class 546, subclass 290+.

**Group 4.** Claims 7-9, drawn to a process for producing acrylic acid derivatives of the general formula III, classified in class 546, subclass 290+.

**Group 5.** Claims 10, 11, 13, 14 and 15, drawn to a process for producing compounds of the general formula IV, classified in class 568, subclass 310+.

**Group 6.** Claims 16-24, 27-30 and 32-35, drawn to a process for producing compounds of the general formula IV-1, classified in class 568, subclass 310+.

**Group 7.** Claims 25, 26, 31 and 36, drawn to a process for producing compounds of the general formula IV-2, classified in class 568, subclass 310+.

**Group 8.** Claims 37 and 38, drawn to a process for producing compounds of the general formula XII, classified in class 568, subclass 310+.

**Group 9.** Claims 39 and 40, drawn to a process for producing  $\alpha$ -alkoxymethylenecarbonyl compounds of the general formula XV, classified in class 556, subclass 400+.

The inventions of Groups 1-2 and Groups 3-9 are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the compounds as claimed can be made by another and materially different process such as the process disclosed in US 5,830,890. Therefore there is no special technical feature for the compounds, the processes of making these compounds or the different fields of application of the compounds. Also there is no unity of invention.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter and search of the nine groups designated above would impose an undue burden upon the Examiner, restriction for examination purposes as indicated is proper.

A telephone call was made to Dennis Lapointe on 8/9/05 to request an oral election to the above restriction requirement, but did not result in an election being made.

**Applicant is requested to elect a specifically disclosed species of the invention to be examined for search purposes.**

Applicants' are reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chukwuma O. Nwaonicha whose telephone number is 571-272-2908. The examiner can normally be reached on Monday thru Friday, 8:30am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann R. Richter can be reached on 571-272-0646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Chukwuma O. Nwaonicha, Ph.D.  
Patent Examiner  
Art Unit: 1621



Johann R. Richter, Ph.D., Esq.  
Supervisory Patent Examiner,  
Technology Center 1600